

### REMARKS

This Amendment is submitted in response to the Office Action dated September 11, 2002. In the Office Action, the Patent Office required restriction of the application to one of the following inventions: Group I, Claims 1-7, drawn to a form product; and Group II, Claims 8-13, drawn to a method of making a mailpiece form. The Patent Office also objected to the form of the Information Disclosure Statement as failing to comply with 37 CFR §1.98(a)(2) which requires a legible copy of each U.S. Patent and foreign patent. Further, the Patent Office rejected Claims 1-7 under the judicially created doctrine of obvious-type double patenting as being unpatentable over Claims 1 and 4 of *Petkovsek* (U.S. Patent No. 6,089,613) in view of *Lockhart et al.* (PAP US 2002/0103697). Claims 1-7 were rejected under 35 U.S.C. §103(a) as being obvious over *Crandall et al.* (U.S. Patent No. 5,782,494).

The Patent Office required restriction of the application to one of the following inventions: Group I, Claims 1-7 or Group II, Claims 8-13. In a telephone conversation on August 29, 2002, Applicant's attorney elected, with traverse, the claims of Group I, namely Claims 1-7. Applicant herewith affirms this election and cancels Claims 8-13.

By the present amendment, Applicant amended Claims 1 and 5. Applicant submits that the amendments to the claims overcome the rejections by the Patent Office for the reasons that follow and

that the application is now in condition for allowance.

With respect to the objection of the Information Disclosure Statement for allegedly failing to meet the requirement of CFR §1.98(a)(2), Applicant herewith submits a legible copy of each U.S. Patent and foreign patent.

In the Office Action, the Patent Office rejected Claims 1-7 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over *Petkovsek* in view of *Lockhart et al.* Applicant submits that this rejection has been overcome by the amendment to Claim 1 and for the reasons that follow.

*Petkovsek*, the Patent Office alleges, discloses a form having a first layer made up of a plurality of parts with a front side and a back side wherein the front side receives indicia, and the backside comprises a removable adhesive; and a second layer having a front side with a non-adhesive layer wherein one of a plurality of parts receives special service mail information, sender information, and recipient information; and a post card section. The Patent Office admits that *Petkovsek* does not disclose a plurality of parts that receive electronically imaged postage accessed over a global computer network necessary to effect delivery of a mailpiece. The Patent Office alleges *Lockhart et al.* disclose a form comprising electronically imaged postage imaged over a global computer network, as allegedly evidenced by Figure 8.

However, amended Claim 1 requires a form having a first layer having a front side and a back side wherein the front side of the first layer has a plurality of parts. A first part receives a first type of electronically-imaged postage accessed over a global computer network. A second part receives a second type of electronically-imaged postage accessed over a global computer network. The first type of electronically-imaged postage is different from the second type of electronically-imaged postage. In addition, one of the first type of electronically-imaged postage and the second type of electronically-imaged postage is necessary to effect the delivery of the mailpiece by the special service.

*Petkovsek* does not disclose a form for delivery of a mailpiece by special service wherein a first part receives a first type of electronically-imaged postage accessed over a global computer network and a second part receives a second type of electronically-imaged postage accessed over a global computer network wherein the first type of electronically-imaged postage is different from the second type of electronically-imaged postage. Moreover, *Petkovsek* does not even remotely teach or suggest this feature.

*Lockhart et al.* also do not disclose a form having a first part which receives a first type of electronically-imaged postage accessed over a global computer network and a second part which receives a second type of electronically-imaged postage accessed over a global computer network. Rather, *Lockhart et al.* merely

disclose a single type of electronically-imaged postage accessed over a global computer network wherein the postage is received in only one part of the form. *Lockhart et al.* do not even remotely teach or suggest a form which receives more than one type of electronically-imaged postage wherein a first type of postage is received in a first part of the form and a second type of postage is received in a second part of the form.

Therefore, it would not have been obvious to one having ordinary skill in the art at the time the invention was made to modify *Petkovsek* with *Lockhart et al.* to achieve the Applicant's invention. Accordingly, the rejection under the judicially created doctrine of obviousness-type double patenting is improper in view of the amended claims and should be withdrawn. Notice to that effect is requested.

With respect to the rejections of Claims 1-7 under 35 U.S.C. §103(a) as being unpatentable over *Crandall et al.*, the Patent Office alleges that *Crandall et al.* disclose:

a first layer (21) having a front side (26) and a back side (22) wherein the front side has a plurality of parts (various sections divided by die-cut) which receive indicia; a second layer (25) having a front side (A) with a non-adhesive layer (Col. 5, lines 4-17), wherein the plurality of parts are removably secured (by adhesive 27).

However, the Patent Office admits that *Crandall et al.* do not disclose a plurality of parts that receive electronically imaged postage accessed over a global network, special mail information,

sender and recipient information, a postcard subsection or a special mailing service section.

As stated above, amended Claim 1 requires a form having a first part which receives a first type of electronically-imaged postage accessed over a global computer network and a second part which receives a second type of electronically-imaged postage accessed over a global computer network. The first type of electronically-imaged postage is different from the second type of electronically-imaged postage.

By admission of the Patent Office, *Crandall et al.* do not disclose a plurality of parts that receive electronically imaged postage accessed over a global network. Further, *Crandall et al.* do not teach or suggest a form having a first part which receives a first type of electronically-imaged postage accessed over a global computer network and a second part which receives a second type of electronically-imaged postage accessed over a global computer network wherein the first type of electronically-imaged postage is different from the second type of electronically-imaged postage. Accordingly, a person of ordinary skill in the art would not have been motivated to modify *Crandall et al.* to achieve the present invention.

The Patent Office alleges that Claims 1, 3, 6 and 7 are unpatentable for allegedly having an insufficient functional relationship between indicia and substrate. However, Claim 1 has

been amended to require a form having a first part which receives a first type of electronically-imaged postage accessed over a global computer network and a second part which receives a second type of electronically-imaged postage accessed over a global computer network. The first type of electronically-imaged postage is different from the second type of electronically-imaged postage. Moreover, either type of electronically-imaged postage is necessary to effect delivery of a mailpiece. Applicant submits that receiving a first type of electronically-imaged postage in a first part of the form or receiving a second type of electronically-imaged postage in a second part of the form, is functionally related to the substrate. Accordingly, Applicant asserts that Claim 1 as amended provides a functional relationship between indicia and substrate.

In addition, a person of ordinary skill in the art would never have been motivated to modify the teaching of *Crandall et al.* in the manner suggested by the Patent Office in formulating the rejection under 35 U.S.C. §103(a).

It is submitted that the question under §103 is whether the totality of the art would collectively suggest the claimed invention to one of ordinary skill in this art. In re Simon, 461 F.2d 1387, 174 USPQ 114 (CCPA 1972).

That elements, even distinguishing elements, are disclosed in the art is alone insufficient. It is common to find elements

somewhere in the art. Moreover, most if not all elements perform their ordained and expected functions. The test is whether the invention as a whole, in light of the teaching of the reference in its entirety, would have been obvious to one of ordinary skill in the art at the time the invention was made. Connell v. Sears, Roebuck & Co., 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983).

It is insufficient that the art disclosed components of Applicant's invention, either separately or used in other combinations. A teaching, suggestion, or incentive must exist to make the combination made by Applicant. Interconnect Planning Corp. v. Feil, 774 F.2d 1132, 1143, 227 USPQ 543, 551 (Fed. Cir. 1988).

*Crandall et al.* lacks the critical features and structural relationships positively recited in the amended claims. Accordingly, the rejection under 35 U.S.C. §103(a) is improper in view of the amended claims and should be withdrawn. Notice to that effect is requested.

Claims 2-7 depend from Claim 1. These claims are also believed allowable over the references of record for the same reasons set forth with respect to their parent claim since each sets forth additional structural elements of Applicant's form.

In view of the foregoing remarks and amendments, Applicant respectfully submits that all of the claims in the application are in allowable form and respectfully solicits allowance of the same.

If, however, any outstanding issues remain, Applicant urges the Patent Office to telephone Applicant's attorney so that the same may be resolved and the application expedited to issue. Applicant requests the Patent Office to indicate all claims as allowable and to pass the application to issue.

Respectfully submitted,

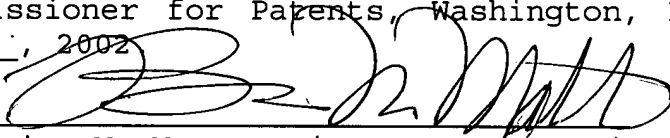


(Reg. No. 35,018)

Brian M. Mattson  
Patents+TMS  
A Professional Corporation  
1914 N. Milwaukee Ave.  
Chicago, Illinois 60647  
Telephone: (773) 772-6009  
Attorney for Applicant

**CERTIFICATE OF MAILING**

I hereby certify that this Amendment is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to: Asst. Commissioner for Patents, Washington, D.C. 20231 on Dec 11, 2002



Brian M. Mattson (Reg. No. 35,018)



VERSION WITH MARKINGS TO SHOW CHANGES MADE

IN THE CLAIMS:

Claim 1, as amended, follows:

1. (Amended) A form for delivery of a mailpiece by a special service, the form comprising:

a first layer having a front side and a back side wherein the front side of the first layer has a plurality of parts and further wherein [the plurality of parts] a first part receives a first type [one of a plurality of types] of electronically-imaged postage accessed over a global computer network and further wherein a second part receives a second type of electronically-imaged postage accessed over a global computer network wherein the first type of electronically-imaged postage is different from the second type of electronically-imaged postage and further wherein one of the [postage] first type of electronically-imaged postage and the second type of electronically-imaged postage is necessary to effect the delivery of the mailpiece by the special service.

5. (Amended) The form of Claim 1 further comprising a special mailing service section that receives special mailing service information.